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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,329	09/16/2003	Hisashi Hotta	Q75433	9174

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EXAMINER

GILLIAM, BARBARA LEE

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 08/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/662,329

Applicant(s)

HOTTA, HISASHI

Examiner

Barbara Gilliam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 11 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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In view of applicant's remarks, the rejections made in the last office action are withdrawn.

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6716567.

Although the conflicting claims are not identical, they are not patentably distinct from each other because even though the patent does not specifically set forth in the claims that there is a hydrophilic layer next to the support, the patent discloses that the support goes through anodizing treatment with alkali solution. This will result in the formation of an oxide layer, which is hydrophilic. The 3 grained structures as undulations, large, medium and small, are set forth in patent claim 2 and column 4. The photosensitive layer in the reference represents the image recording layer of the present claims. The photosensitive layer includes water-insoluble and alkali soluble resin and an infrared absorbent and heating increases the solubility.

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3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

4. Nishino, US pat. No. 6024858 discloses state of the art of making presensitized plates with different sized pits.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 1 and rejected under 35 U.S.C. 102(a) as being anticipated by WO02/034544. (translation shown in 6716567.)

7. The WO reference discloses a presensitized plate having a photosensitive layer that can become alkali soluble by heating. The support for the plate comprising pits (undulations) in three separate sizes. The large, medium and small sizes are shown in column 5 of translation, '567. See lines 3-7 which discloses large as 2 to 10 um wavelength, medium as 0.05 to 0.5 um and small as micrograined grained structure. The micro grained structure is further defined in col. 8, lines 60-62 as 0.005 to 0.1 um. The sizes meet applicant's size ranges. The recording layer of the reference is represented by the photosensitive layer, which is alkali soluble upon heating and is also insoluble in water. See column 35, lines 61-67. The inclusion of an infrared absorbent is also disclosed at column 35, line 66-67 and column 41, lines 27-28. The reference does not specifically state that a hydrophilic layer is present. However, a

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hydrophilic layer must be present in the instant invention as it present in the reference. Applicant teaches the same presensitized plate with the same undulations as the reference. The reference further teaches treating the aluminum support in the same manner as applicant claims. The reference teaches obtaining the aluminum support by subjecting it to mechanical graining, chemical etching, desmutting with an acid, electrochemical graining using an electrolyte, chemical etching with alkali aqueous treatment and desmutting in this order. See columns 48 and 49 entirely. While the hydrochloric acid treatment is not mentioned in the example in column 48, use of hydrochloric treatment as well as nitric acid treatment is taught at column 6 where it is taught that use of multiple electro graining treatments are often used. This feature is also taught in column 7 at lines 29-34. The plate is then anodized and will form an oxide layer, which is hydrophilic layer (although not specifically named as such). The anodized plate has been treated with acid and electric current run through it. This forms the oxide layer. See column 49. The conductivity would be inherent since the same materials were treated in the same manner. The plate is then subjected to treatment by alkali metal silicate. See column 50.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara Gilliam whose telephone number is 571 272-1330.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly, can be reached on 571 272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700